

Serial No.: 10/788,475
Amdt. Dated: September 27, 2007
Reply to Office Action dated June 27,
2007

46058

REMARKS

Claims 5-9, 20-27 and 41-62 are pending with claims 5, 20, 41 and 52 being independent. Claims 1-4, 10-19 and 28-40 are withdrawn. Applicants note with appreciation the allowance of claims 41-51.

By the present Amendment, claims 5-8, 20-27, 52, 55-62 have been amended. The specification has been amended to correct typographical errors.

Oath/Declaration

A corrected Declaration is attached to overcome the objection set forth in the office action.

Drawings

The objection to the drawings has been overcome by the amendment to the specification herein.

Claim Objection

Claim 57 has been amended herein to overcome the objections to claims 57-62 stated in the office action.

Claim Rejections – 35 U.S.C. § 101

The claim rejection under 35 U.S.C. §101 is believed to be overcome by amended claims 58-62 herein.

Claim Rejections – 35 U.S.C. § 102

Claims 5-9, 20-27 and 52-62 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication 2003/0028089, to Galley et al. Applicants respectfully submit that Examiner's stated basis for rejecting the claims is confusing and incomplete.

The Examiner states that the language "for determining factors for insulin therapy" in the preamble of claim 5 and the recitation "for storing at least one data set ..." describing the memory device recited in claim 5 is merely intended use language describing the intended use of the memory device which cannot be relied upon to define over the prior art. The Examiner appears to be relying on MPEP § 2111.02 relating to preamble statements reciting purpose or intended use, and on MPEP § 2114 relating to functional language in apparatus and article claims which states the manner of operating a device does not differentiate an apparatus claim over prior art and cites:

"A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987)."

Applicants respectfully submit, however, that a data set as claimed is functional descriptive material that is stored in a memory device as claimed and as such becomes structurally and functionally interrelated to that medium. MPEP § 2106.01. Thus, the recited memory device is not only statutory but its recited data set must be given weight when determining patentability. The Examiner has neglected to do so. In fact, by the Examiner's reasoning, no claim directed to a functional relationship between a memory device and a programmed processing device is patentable, which is certainly not the case under current U.S. patent practice.

Further, whether the preamble language must be read in the context of the claim per MPEP § 2111.02 is not relevant here. The processing device is programmed to use an insulin sensitivity factor, and to determine a carbohydrate to insulin ratio for the at least one data set recited in the memory device using the insulin sensitivity factor. The programming by which the

programmed processing device uses an insulin sensitivity factor, and determines a carbohydrate to insulin ratio for the at least one data set using the insulin sensitivity factor imparts functionality when employed as a computer component such as a processing device and therefore must be given weight when determining patentability. MPEP § 2106.01. The Examiner has neglected to do so.

Since the Examiner has interpreted claim 5 as merely reciting a memory device and a processing device without further limitation, Galley et al was merely relied on to teach a memory device and a processing device with particular reference to paragraphs [0033] through [0035]. Applicants respectfully submit that Galley et al fails to teach or suggest the claim 5 recitations of storing a data set as claimed and the programmed processing device operations as claimed. Further, Applicants respectfully submit that Galley et al fails to teach or suggest the claim 20 recitations of storing a data set as claimed and the programmed processing device operations as claimed. Finally, Applicants respectfully submit that Galley et al fails to teach or suggest the claim 52 recitations of storing a data set as claimed and the programmed processing device operations as claimed.

While Applicant believes that the Examiner's reasoning for not interpreting the recitations of the independent claims 5, 20 and 52 in their entirety is incorrect, the Applicant has nonetheless amended the claims to more affirmatively recite a claimed memory device "storing" a certain type of data rather than being merely "for storing" a certain type of data. Similarly, the proposed amended claims recite a processing device "programmed" to perform certain operations rather than being merely "programmable" to do these operations.

In view of the foregoing, withdrawal of the rejection of claims 5-9, 20-27 and 52-62 under 35 U.S.C §102(b) as being anticipated by Galley et al is respectfully requested. If the Examiner does not allow the application and continues to reject the claims over Galley et al, then the Applicant respectfully submits that the next office action be non-final since the Examiner did not state how Galley et al teaches most of the limitations of the claims. Thus, Applicant has not been afforded an opportunity to respond to the specific rejections of the claims based on this

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reference. Further, none of the claim amendments herein were made to overcome the 35 U.S.C §102(b) rejection and therefore do not necessitate a new ground for rejection.

Conclusion

In view of the amendments and arguments set forth above, Applicants submit that the present application is in condition for allowance and would appreciate early notification of the same.

Invitation for a telephone interview

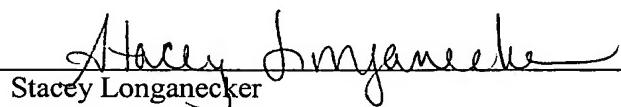
The Examiner is invited to call the undersigned at (202) 659-9076 if further issues remain with allowance of this case.

Deposit Account Authorization

Although no fee is believed due by submission of this paper, authorization is hereby made to charge any fees due or outstanding, or credit any overpayment, to Deposit Account No. 18-2220 (Order No. 46058).

Respectfully Submitted,

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